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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,317	06/28/2001	Stephen R. LaPierre	36968-255226	7981

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EXAMINER

ESCALANTE, OVIDIO

ART UNIT PAPER NUMBER

2645

DATE MAILED: 07/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/894,317

Applicant(s)

LAPIERRE ET AL.

Examiner

Ovidio Escalante

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). _____
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: |

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DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement submitted on August 31, 2001 was received. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly the information disclosure statement is being considered by the examiner.

Drawings

2. The formal drawings submitted on June 28, 2001 have been approved by the drafts person.

Specification

3. The disclosure is objected to because of the following informalities: in pages 1 and 2, the Examiner respectfully ask Applicants to indicate the US Serial Number of the related applications. Appropriate correction is required.

Claim Objections

4. Claims 18 and 41 are objected to because of the following informalities: claims 18 and 41 depend upon themselves. The Examiner will examine claim 18 as if it depends upon claim 17 and claim 41 as if it depends upon claim 39.

5. Claim 19 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 3. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Appropriate correction is required.

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6. Claims 17 is objected to because there is an obvious grammatically error with "...status certification for a video mail message an asynchronous dialog in a video-enabled...."

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 22 and 41 recite the limitation "said asynchronous dialog" in line 3. There is insufficient antecedent basis for this limitation in these claims.

9. Claims 18,21 and 40 recites the limitation "said reply" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 17 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Picard et al. US Patent No. 6,233,318.

Regarding claim 17, Picard teaches a method for providing a status certification for a video mail message asynchronous dialog in a video-enabled communications network (col. 7, lines 13-19; Picard teaches of providing status information for video, voice, e-mail and facsimile messages) comprising:

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(a) assigning a message identifier for said first video mail message, (col. 13, lines 22-32; each message has an identifier so that it can be located);

(b) creating a disposition identifier in response to a disposition event, (col. 7, lines 13-19);

(c) associating said disposition identifier with said first video mail message, (col. 2, lines 26-33; col. 7, lines 13-19);

(d) compiling said disposition identifier and said first video mail message identifier to create a status notification in response to a triggering event, (col. 2, lines 26-33; col. 7, lines 13-19); and

(e) storing said status notification in a temporary video mailbox, (col. 18, lines 29-38).

Regarding claim 18, Picard teaches (f) receiving said reply; (g) associating said reply with said first video mail message, (col. 8, lines 42-54); and (h) storing said reply in said temporary video mail box, (col. 15, lines 31-40).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claims 1-4,7-16,19-23,26-42,45-50,52 and 54-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson et al. US Patent 6,014,427 in view of Bartholomew US Patent 6,285,745.

Regarding claims 1 and 20, Hanson teaches a method and system for providing a status certification for a first voicemail message in a telecommunications network (abstract; figs. 7-9; col. 9, lines 48-64; the message originator can receive a certified status report for a message) comprising:

(a) assigning a message identifier for said first voicemail message, (e.g. ID#002), (col. 5, lines 52-55; col. 9, lines 23-29);

(b) creating a disposition identifier in response to a disposition event, (col. 5, lines 55-61; the disposition identifier relates to among other things, message recipients who have replied or have not responded to a message);

(c) associating said disposition identifier with said first voicemail message, (col. 5, lines 55-61; col. 9, lines 4-22);

(d) compiling said disposition identifier and said first voicemail message identifier to create a status notification in response to a triggering event, (col. 5, lines 52-61; col. 9, lines 4-47); and

(e) storing said status notification in a voicemail box, (col. 9, lines 4-47).

While Hanson does not specifically teach that the voicemail box is a “temporary” voicemail box, the Examiner notes that it would have been obvious if not inherent that Hanson

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has a “temporary” voicemail box since Hanson does not state that the voicemail box is permanent. Furthermore, if the voicemail box of Hanson was permanent it would only be permanent while the user is a subscriber to the system and not when the user ceases to be a subscriber therefore, one skilled in the art will view this as a temporary voice mailbox.

Nonetheless, Bartholomew teaches that it was well known in the art to store messages in a temporary voice mailbox, (col. 24, lines 42-54). Bartholomew teaches that one would have been motivated to have a temporary box so that parties who are not subscriber to voice mail can still receive voice mail messages from voice mail senders.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Hanson by including a temporary voice mailbox as suggested by Bartholomew so that called parties who do not possess voice mail boxes can still receive voice mail messages from senders.

Regarding claims 2,21 and 40, Hanson in view of Bartholomew teach (f) receiving a first reply; (g) associating said first reply with said first voicemail message, (col. 7, lines 17-24); and (h) storing said first reply in said temporary voicemail box, (col. 9, lines 4-27).

Regarding claims 3,19,22 and 41, Hanson teaches (i) billing a party to said first voicemail message for said providing of said status certification, (col. 7, lines 17-24).

Regarding claims 4,23 and 42, Hanson teaches an asynchronous dialog among user of the telecommunication system, (abstract; col. 7, lines 17-24; the sender sends a message to a recipient and the recipient sends a message back to the sender.)

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Regarding claim 7,26 and 46, Hanson teaches wherein said disposition event comprises at least one of: a managing event; and a dispatching event, (col. 5, lines 52-61; col. 9, lines 38-47).

Regarding claim 8,27and 47, Hanson teaches wherein said managing event comprises at least one of: accessing said first voicemail message and presenting an indication of said first voicemail message, (col. 5, lines 52-61; col. 9, lines 48-64).

Regarding claim 9,28 and 48, Hanson teaches wherein said managing event comprises denying said status certification of said first voicemail message, (col. 9, lines 48-64).

Regarding claim 10,29 and 49, Hanson teaches wherein said dispatching event comprises at least one of: forwarding said first voicemail message; and replying to said first voicemail message, (col. 7, lines 17-24).

Regarding claim 11,30 and 54, Hanson teaches wherein said first voicemail message identifier an alphanumeric identifier, (fig. 9).

Regarding claim 12,31 and 55, Hanson teaches wherein said first voicemail message identifier comprises at least one of: a role identifier; a party identifier; a date identifier; and a time identifier, (col. 9, lines 4-47).

Regarding claim 13,32 and 56, Hanson teaches wherein said role identifier comprises at least one of: an originator; a sender; a caller and a recipient, (fig. 9; sender and recipients are identified in the message).

Regarding claim 14,33 and 57, Hanson teaches wherein said party identifier comprises an access address, (fig. 9; e.g. sender 908-555-1234).

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Regarding claim 15,34 and 58, Hanson teaches storing an attribute for said status certification for said first voicemail message, wherein said attribute comprises at least one of: said first voicemail message identifier; said disposition identifier; said reply; and said status notification, (figs 7-9; col. 9, lines 4-37).

Regarding claim 16,35 and 59, Hanson teaches an administrative functionality, wherein said administrative functionality comprises at least one of: monitoring said attribute informing a recipient of said attribute, (col. 7, line 55-col. 8, line 3; col. 9, lines 4-47).

Regarding claim 36, Hanson teaches a data repository operative to store said attributes, (col. 3, lines 16-32).

Regarding claim 37, Hanson teaches wherein said data repository comprises a database, (fig. 2; col. 3, lines 16-32).

Regarding claim 38, Hanson teaches wherein said data repository comprises: a first database for storing said first voicemail message; and a second database for storing said attribute, (fig. 2).

Regarding claim 39, Hanson teaches a system to provide a status certification for a voicemail message in a telecommunication network comprising an intelligent peripheral, (col. 9, lines 48-64) operative to:

- (a) assign a message identifier for said first voicemail message, (col. 5, lines 52-55; col. 9, lines 23-29);
- (b) create a disposition identifier in response to a disposition event, (col. 5, lines 55-61; the disposition identifier relates to , among other things, message recipient who have relied to the sender's message); and

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(c) associate said disposition identifier with said first voicemail message, (col. 5, lines 55-61)

(d) compile said disposition identifier and said first voicemail message identifier to create said status notification in response to a triggering even, (col. 5, lines 52-61; col. 9, lines 4-47)

(e) store said status notification in a voicemail box, (col. 7, lines 17-24; col. 9, lines 4-47)

While Hanson does not specifically teach that the voicemail box is a “temporary” voicemail box and of using the system in an AIN system, the Examiner notes that it would have been obvious if not inherent that the Hanson would have had a “temporary” voicemail box since Hanson does not state that the voicemail box is permanent. Furthermore, if the voicemail box of Hanson was permanent it would only be permanent while the user is a subscriber to the system and not when the user ceases to be a subscriber therefore, one skilled in the art will view this as a temporary voice mailbox.

Nonetheless, Bartholomew teaches that it was well known in the art to store messages in a temporary voice mailbox, (col. 24, lines 42-54). Bartholomew further teaches that it was well known in the art to have a messaging system in an AIN network system, (col. 18, lines 28-40). Bartholomew teaches that one would have been motivated to have a temporary box in an AIN system so that parties who are not subscribers to voice mail can still receive voice mail messages from the sender.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Hanson by including a temporary voice mailbox in an AIN system as suggested by Bartholomew so that called parties who do not possess voice mail boxes can still receive voice mail messages from the message originator.

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Regarding claim 45, Hanson teaches wherein said triggering event comprises at least one of: a disposition event; and a passage of time, (col. 9, lines 4-47).

Regarding claim 50, Hanson in view of Bartholomew teaches a service switching point functionally connected to said intelligent peripheral; and an interface functionally connected to a service switching point and operative to accept communications from a second communications network, (fig. 1; col. 18, lines 28-40; Bartholomew teaches that it was well known in the art to use an AIN system and therefore, it would have been obvious to have a SSP and IP interconnected to other networks).

Regarding claim 52, Hanson teaches a computer network functionally connected to said interface and operative to facilitate access to said status notification by a computer network client device, (fig. 1).

15. Claims 5,6,24,25,43,44 rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson in view of Bartholomew and further in view of Cloutier US Patent 6,459,913.

Regarding claims 5-6,24-25 and 43-44, while Hanson in view of Bartholomew teach of communication a message to a recipient and having the recipient reply back to the sender of the message and of an asynchronous dialog among users of the telecommunications system (AIN), Hanson and Bartholomew does not teaches of receiving a second reply to the first reply.

Cloutier teaches that it was well known in the art to have an asynchronous dialog between to end users, (col. 2, lines 61-67). Cloutier further teaches wherein said asynchronous dialog comprises: receiving a second reply (voice mail message) to at least one of said first reply and said first voicemail message; associating said second reply with said first voicemail message; and storing said second reply, (abstract; col. 2, lines 61-67).

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Hanson and Bartholomew by allowing the user to have an asynchronous dialog as taught by Cloutier so that parties may converse with each other without establishing a real time connection.

16. Claims 51 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson in view of Bartholomew and further in view of LaPorta et al. US Patent 6,014,429.

Regarding claims 51 and 53, while Hanson teaches of using wireless device and personal communication devices, Hanson does not specifically teach of a MTSO function connected to an interface and a personal digital assistance communicating to the network.

LaPorta teaches of a system for allowing a user to send a message to plural recipient and to allow the plural recipients to reply back to the sender. LaPorta further teaches that it was well known in the art to have a mobile telephone switching office (MTSO) functionally connected to said interface and operative to facilitate access to said status notification by a cellular device, (col. 17, lines 33-56). LaPorta further teaches a personal digital assistant communications network functionally connected to an interface and operative to facilitate access to a status notification by a personal digital assistant, (col. 7, lines 1-6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Hanson and Bartholomew by using a MTSO or a PDA as suggested by LaPorta so that the wireless device of Hanson can communicate with the messaging network.

Conclusion

17. Any response to this action should be mailed to:

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Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Or:

(703) 872-9314, (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal
Drive, Arlington, VA, Sixth Floor (Receptionist).

18. Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Ovidio Escalante whose telephone number is (703) 308-6262.
The examiner can normally be reached on Monday to Friday from 6:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Fan Tsang, can be reached on (703) 305-4895. The fax phone number for this Group
is (703) 872-9314.

Communications via Internet e-mail regarding this application, other than those under 35
U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be
addressed to [fan.tsang@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO
employees do not engage in Internet communications where there exists a possibility that
sensitive information could be identified or exchanged unless the record includes a properly

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signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Ovidio Escalante
Examiner
Group 2645
July 3, 2003

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

A handwritten signature in black ink, appearing to read 'Fan Tsang', with a stylized flourish at the end.